

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 13, 16, 20-27, 29, 31, 32 and 34-36 will have been amended and are resubmitted for consideration by the Examiner. Further, claims 37-39 will have been canceled without prejudice or disclaimer. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for an indication of the allowability of claims 30-31, 35 and 36.

Turning to the merits of the action, the Examiner has rejected claims 13-15, 20-22, 27 and 40 under 35 U.S.C. §103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of PAUL (U.S. Patent No. 5,999,932). The Examiner also has rejected claims 16-19, 23-27, 32, 38-39 and 41 under 35 U.S.C. § 103 (a) as being unpatentable over TOYODA et al. (U.S. Patent Number 5,812,278) in view of PAUL (U.S. Patent No. 5,999,932), PRAITIS et al. (U.S. Patent No. 6,594,697) and MORI (U.S. Patent No. 6,417,930). The Examiner further has rejected claims 28-29 and 33-34 under 35 U.S.C. § 103 (a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of PAUL (U.S. Patent No. 5,999,930), PRAITIS et al. (U.S. Patent No. 6,594,697), MORI (U.S. Patent No. 6,417,930), and IWAZAKI (U.S. Patent No. 6,687,742).

As noted above, Applicant has amended claims 13, 16, 20-27, 31, 32 and 34-36 for consideration by the Examiner and has canceled claims 37-39 without prejudice or disclaimer. Thus, claims 13-29, 32-34 and 40-41 remain pending for consideration. Applicant notes that

claims 30-31 and 35-36 have been indicated to be allowable, for which the Examiner is respectfully thanked.

Applicant respectfully traverses the above rejections of pending claims 13-29, 32-34 and 40-41, and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amendments to the claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-15 relate to an image communication apparatus which has a transmitter configured to transmit an e-mail with data attached, via a server through a computer network and has a receiver configured to receive an e-mail with data attached, via the server through the computer network. The image communication apparatus comprises a controller configured to convert the attached data into image data. The controller judges whether or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string. The predetermined character string is related to a sender of the error mail. The error mail is related to the e-mail transmitted by the image communication apparatus. The controller determines the received that e-mail is an error mail when it is judged that the header of the received e-mail includes the predetermined character string. The predetermined character string is set in the header of the received e-mail by the server. Claims 20-22 recite related methods.

Applicant's claims 16-19 relate to an image communication apparatus which transmits and receives an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image

communication apparatus also has a controller configured to convert the attached data to image data. The controller further searches for a predetermined image data fixed code in the image data part of the body of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected. The error mail is related to an e-mail transmitted by the image communication apparatus. The predetermined image data fixed code is set into the image data part of the body of the e-mail by the image communication apparatus. Claims 23-26 recite related methods.

Applicant's claims 27-29 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail to which data is attached, via the server. The image communication apparatus has a converter configured to convert the attached data into image data and a memory that is configured to store a predetermined image data fixed code. Further, the image communication apparatus has a controller which searches for a predetermined header fixed message in the header of the received e-mail, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not found in the header of the received e-mail, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory. The error mail is related to an e-mail transmitted by the image communication apparatus. The predetermined image data fixed code is set in the image data part of the body of the e-mail by the image communication apparatus. Claims 32-34 recite related methods.

Regarding the rejection of claims 13-15, 20-22, 27 and 40 under 35 U.S.C. § 103(a), TOYODA et al. does not disclose a controller that determines that the received e-mail is the error mail, when it is judged that the header of the received e-mail includes the predetermined character string, as the Examiner admits in the Official Action mailed on October 11, 2006. In particular, the Examiner admits that TOYODA did not specifically teach to draw conclusion that the e-mail is an error mail if the header of the received e-mail is judged to include the predetermined character string, the predetermined character string being related to a sender of the error mail.

TOYODA et al. also does not teach that the predetermined character is set in the header of the received e-mail “by the server” as recited. Rather, in TOYODA et al., a mail address of the receiver written in the header of the receiver’s electronic mail “by the receiver” is compared with the receiver’s electronic mail address retrieved from the corresponding table (col. 27, lines 44-56). In other words, in TOYODA et al., a mail address of the receiver is written in the header of the receiver’s electronic mail by the receiver. Thus, TOYODA et al. does not contain any disclosure regarding the predetermined character that is set into the header of the received e-mail by the server.

Thus, the pending claims are clearly distinguished over TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant’s pending claims 13-15, 20-22, 27 and 40 are not disclosed or even suggested in TOYODA et al. cited by the Examiner.

In setting forth the rejection, the Examiner relies on PAUL to supply the shortcomings of TOYODA et al. However, PAUL relates to a system for eliminating unsolicited electronic mail. In PAUL, data from one or more fields of incoming electronic mail messages are

compared with the identification data stored in the user inclusion list. When the electronic mail message data matches corresponding identification data from the user inclusion list, the e-mail message is marked with a first display code, such as "OK". On the other hand, when no match is detected, the system determines whether the electronic mail message may be of interest to the user. When the message is determined to satisfy predetermined criteria, the message is marked with a second display code, such as "NEW". When the message is determined not to satisfy the predetermined criteria, the message is marked with a third display code, such as "JUNK".

However, PAUL does not disclose a controller that determines that the received e-mail is error mail, when it is judged that the header of the received e-mail includes the predetermined character string. Rather, PAUL merely discloses a system for blocking unsolicited mail, but does not relate to determining whether a received mail is an error mail or not. In other words, in PAUL, unsolicited mail is not related to the e-mail transmitted by the image communication apparatus, but comes from some other source. In stark contrast, in the pending claims, the error mail is related to the e-mail transmitted by the image communication apparatus. Thus, PAUL does not contain any disclosure regarding a controller that determines that the received e-mail is error mail (as defined), when it is judged that the header of the received e-mail includes the predetermined character string.

PAUL also does not teach that the predetermined character is set into the header of the received e-mail "by the server". Rather, PAUL merely discloses a system for blocking unsolicited mail, but does not relate to determining whether a received mail is an error mail or not. Thus, PAUL does not contain any disclosure regarding the predetermined character string that is set into the header of the received e-mail by the server.

Thus, PAUL does not disclose or supply the features of the present invention that are missing from TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15, 20-22, 27 and 40 are not disclosed in PAUL cited by the Examiner. Thus, pending claims 13-15, 20-22, 27 and 40 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor PAUL discloses the combination of features recited in Applicant's claims. Specially, TOYODA et al. does not provide any suggestions for modifying the image apparatus by the utilization of a predetermined character string that is related to a sender of the error mail, as recited in at least claim 13.

Moreover, the Examiner has not set forth a proper motivation supporting the proposed combination of the features of TOYODA et al. and PAUL. In particular, the Examiner's stated reason for obviousness does not flow from the prior art. In particular, Applicant respectfully submits that there is no reason or motivation for combining the teachings of the junk mail filter of PAUL with the device of TOYODA et al. which relates to failures in transmission of an electronic mail. TOYODA et al. is not dealing with determining whether a message is desired or undesired (such as by labeling the same OK NEW or JUNK), but for determining whether a failure in transmission has occurred. Thus, the problems addressed by TOYODA et al. and PAUL are quite distinct.

The Examiner has set forth no reason why one should combine the features of these two diverse references. In addition, neither PAUL nor TOYODA et al. teaches the explicitly recited feature of the claims that the predetermined character string is set into the header of the received e-mail "by the server". For this additional reason, it is respectfully submitted that the proposed

combination of TOYODA et al. and PAUL, even if motivated (to which Applicant do not acquiesce) is inadequate to render unpatentable any of the claims in the present application.

Moreover, Applicant notes that the Examiner has provided no motivation or suggestion to make the claimed combination, such motivation being found in the prior art and not in Applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Circ. 1991). Neither TOYODA et al. nor PAUL provides any such motivation or suggestion.

Even if the teachings of PAUL could be combined with the teachings of TOYODA et al., which Applicant submits is inappropriate, the mere fact that the references can be combined or modified does not render the resultant combination obvious and motivated unless the prior art also teaches the desirability of the combination. *In re Mills* 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Circ. 1990). Because the relied upon references fail to suggest such a desirability, or provide a motivation or suggestion for the proposed combination, it is respectfully submitted that the Examiner has improperly combined the teachings of TOYODA et al. and PAUL, for this additional reason.

Regarding the rejection of claims 16-19, 23-27, 32, 38-39 and 41 under 35 U.S.C. § 103(a) over TOYODA et al. in view of PAUL, PRAITIS and MORI, as explained above, TOYODA et al. does not disclose the controller of claim 16 that is configured to search for a predetermined image data fixed code and to judge received e-mail as error mail when the predetermined fixed data fixed code is detected, as the Examiner admits in the Official Action mailed on October 11, 2006. In particular, the Examiner admits that TOYODA did not expressly teach for a predetermined image data fixed code in the image data part of the e-mail of the body of e-mail and to judge that the received e-mail is an error mail when the predetermined

image data fixed code is detected. Nor does TOYODA et al. disclose the searching and judging as recited in claim 23.

Further, the Examiner has admitted, in the outstanding Official Action mailed on December 1, 2005, that TOYODA et al. does not disclose a controller which searches for a predetermined image data fixed code in the image data part of the body of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Additionally, TOYADA et al. does not teach that a predetermined image data fixed code is set in the image data part of the body of the e-mail by the image communication apparatus. Rather, in TOYADA et al., a mail address of the receiver written in the header of the receiver's electronic mail by the receiver is compared with the receiver's electronic mail address retrieved from the corresponding table (col. 27, lines 44-56). In other words, in TOYODA et al., a mail address of the receiver is written in the header of the receiver's electronic mail by the receiver. Thus, TOYADA et al. does not contain any disclosure regarding a predetermined image data fixed code that is set in the image data part of the body of the e-mail by the image communication apparatus.

Thus, TOYADA et al. does not disclose a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure. TOYADA et al. also does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is

detected, the predetermined image data fixed code being set in the image data part of the body of the e-mail by the image communication apparatus.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, 32, 38-39 and 41 are not disclosed in TOYODA et al. cited by the Examiner.

PAUL does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, when the predetermined image data fixed code is detected, the predetermined image data fixed code being set in the image data part of the body of the e-mail by the image communication apparatus.

Rather, and as noted above, PAUL merely discloses a system for blocking unsolicited mail, but does not relate to determining whether a received mail is an error mail or not. In other words, in PAUL, unsolicited mail is not related to the e-mail transmitted by the image communication apparatus, while in the pending claims, the error mail is related to the e-mail transmitted by the image communication apparatus. Thus, PAUL does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, when the predetermined image data fixed code is detected.

PAUL also does not teach that a predetermined image data fixed code is set in the image data part of the body of the e-mail by the image communication apparatus. Rather, PAUL merely discloses a system for blocking unsolicited mail, but does not relate to determine whether a received mail is an error mail or not. Thus, PAUL does not contain any disclosure regarding

the predetermined image data fixed code that is set in the image data part of the body of the e-mail by the image communication apparatus.

Thus, PAUL does not disclose the features of the present invention that are missing from TOYODA et al.

PRAITIS et al. relates to a client system in which, when an error is detected, the browser analyzes the response to determine whether the response comprises a friendly error page, and when the response is not the friendly error page, the browser replaces the page returned in the response with a friendly page.

PRAITIS et al. analyzes a response header 94 contained in a response 90 (Fig. 6, 208 and col. 9, lines 36-37). However, the response 90 is a command communicated between the browser module 82 and the networking software module 86 (Fig. 5 and col. 7, lines 19-23), but is not an e-mail as required by the pending claims. Further, PRAITIS et al. detects whether an error occurred in the server, using a status code number contained in the response header 94 (Fig. 6, 210 and col. 9, lines 37-43).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code “in the image data part of the e-mail” when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a status code number in a response header 94 of the response 90 (not an e-mail). PRAITIS et al. does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected, since PRAITIS et al. does not search for a predetermined image data fixed code in the image data part of the e-mail.

Further, PRAITIS et al. analyzes a response body 92 of a response 90 to determine whether the response body 92 is a friendly response (Fig. 6, 212 and col. 9, lines 52-62). However, this decision is not performed for determining whether an error occurs. Rather, when the response body 92 is not a friendly response, the browser of PRAITIS et al. displays (i.e., substitutes) a friendly page instead of the body of the response (col. 9, lines 63-66).

Thus, PRAITIS et al. does not disclose a controller which searches for a predetermined image data fixed code “in the image data part of the e-mail” when the received e-mail is a multi-part structure. Rather, PRAITIS et al. analyzes a response body 92 of the response 90 (not an e-mail). PRAITIS et al. also does not disclose a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected. Rather, PRAITIS et al. replaces the page returned in response with a friendly page, when the response body is not a friendly response.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-26, 27, 32, 38-39 and 41 are not disclosed in PRAITIS et al. cited by the Examiner.

The pending claims 16-19, 23-26, 27, 32, 38-39 and 41 are submitted to be patentable over the Examiner's proposed combination, since none of TOYODA et al., PAUL and PRAITIS et al. disclose the combination of features recited in Applicant's claims. Moreover, there is submitted to be no proper motivation for the combination of the facsimile system of TOYODA et al. with the features of blocking unsolicited mail of PAUL (as noted in detail above) and the features of the software programs of PRAITIS et al. which relates to errors occurring at a server.

MORI relates to a network facsimile apparatus which receives electronic mail via a local area network and transmits facsimile data through facsimile communications procedures via PSTN.

MORI also discloses the sub-headers Z1, Z2, and Z3 including the boundary “Content-Type” (Figs. 5 and 7, and col. 11, lines 33-35). However, the boundary “Content-Type” is contained in a header of an e-mail, but not in a image data part of the body of the e-mail. Thus, MORI does not disclose a controller which searches for a predetermined image data fixed code “in the image data part of the e-mail” when the received e-mail is a multi-part structure.

Further, MORI does not disclose judging that the received e-mail is an error mail, as evidenced by Fig.10AA. Rather, MORI detects series of characters to find the sub-headers (Fig. 10AA, S204, and col. 13, lines 53-57). MORI determines that contents of an information file is a MINE formatted text (Fig. 10AA, S205 and col. 13, lines 63-67). MORI converts the MINE formatted text into original symbol/character codes (Fig.10AA, S206 and col. 14, lines 1-5). Thus, MORI does not contain any disclosure regarding a controller which judges that the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19, 23-27, 32, 38-39 and 41 are not disclosed in MORI cited by the Examiner.

Pending claims 16-19, 23-26, 27, 32, 38-39 and 41 are thus submitted to be patentable over the Examiner's proposed combination, since none of TOYODA et al., PAUL, PRAITIS et al., and MORI, even if combined as proposed, disclose the combination of features recited in Applicant's claims. Furthermore, the combination of these four diverse documents is submitted

to be improper as the Examiner has not set forth a proper motivation for combining the teachings of these diverse documents.

Regarding the Examiner's rejection of the dependent claims 28-29 and 33-34, since these claims are dependent from allowable independent claims 27 and 32, which are allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103(a).

In the rejection of dependent claims 28, 29, 33, and 34, the Examiner relied upon, *inter alia*, IWAZAKI. However, Applicant submits that IWAZAKI is not available as a reference against the pending claims. Applicant notes that the IWAZAKI reference issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000. Thus, its availability as a reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 11-321411 which was filed on November 11, 1999, which is before the 35 U.S.C. § 102(e) date of the IWAZAKI reference relied on by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application.

In view of the fact that IWAZAKI was only applied in the rejection of several dependent claims, and in view of the clear evidentiary showing set forth above regarding the patentability of the respective independent claims, Applicant respectfully declines to file a certified translation of the priority document at this time.

Accordingly, in view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and resubmitted the same for consideration and thus respectfully requests reconsideration of the outstanding rejections by the Examiner.

With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosure of the references. Applicant also has pointed out the impropriety of the rejections, the lack of motivation for the proposed combinations as well as the inadequacy of the references relied on. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application, in due course.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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